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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,346	02/26/2002	Ryuichi Shiohara	Q68718	1680
7590	11/17/2005		EXAMINER PAPANIKOLAOU, ATHANASIOS T	
SUGHRUE MION, PLLC 2100 Pennsylvania Avenue, NW Washington, DC 20037-3213			ART UNIT	PAPER NUMBER
			2627	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/082,346	Applicant(s) SHIOHARA, RYUICHI	
	Examiner Athanasios Tom Papanikolaou	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/26/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The references listed in the Information Disclosure Statement submitted on 3/25/05 have been considered by the examiner (see attached PTO-1449).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 4 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 4 and 14 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory."

Claims 4 and 14, while defining a **"record medium"** do not define a "computer-readable medium" and is thus non-statutory for that reasons. A **"record medium"** can range from paper on which the program is written, to a program simply contemplated

and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, and 10-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Blumberg (U.S. Patent Application Publication 2005/0144256 A1).

Regarding claim 1, Blumberg discloses a **method of editing a markup language** (paragraph 42) **comprising the steps of: describing, in a document transferred to a client computer through a telecommunication line from a server computer, a first embedded command interpreted when the document is displayed by the client computer, the first embedded command causing the client computer to display first image data of an input image (paragraph 9); describing in the document a second embedded command interpreted when the document is printed by the client computer, the second embedded command causing the client computer to print second image data of the input image with a larger number of pixels than the number of pixels of the first image data of the input**

image (paragraph 12, the image is scaled in accordance with the maximum capabilities of the printer which can be a higher resolution than the display image); **and outputting the document with the first and second embedded commands described** (paragraph 59).

Regarding claim 2, Blumberg discloses the dependent limitations of claim 1, as stated above, and further discloses **comprising the step of describing in the document a third embedded command interpreted when the document is printed by the client computer, the third embedded command specifying a document layout** (paragraph 23).

Regarding claim 3, Blumberg discloses the dependent limitations of claim 2, as stated above, and further discloses **further comprising the step of describing in the document a fourth embedded command interpreted when the document is printed by the client computer, the fourth embedded command specifying a page break** (paragraph 42, it is well known in the art how to insert a page break while editing a markup language).

Claim 4 recites identical features as claim 1 except claim 4 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 3 because without a computer readable medium to store a

program that makes it possible for the system to operate, the system taught by Blumberg, the rejections for claim 1 could not function.

Claims 10 through 12 recite identical features as claims 1 through 3, respectively, except claims 10-12 are method claims. Thus arguments similar to that presented above for claims 1-3 are equally applicable to claims 10-12.

Regarding claim 13, Blumberg discloses the dependent limitations of claim 12 and further discloses **comprising the step of interpreting a fourth embedded command described in the document and specifying a page layout when the document is printed** (paragraph 23, the document contains layout information which can include page layout information).

Regarding claim 14, Blumberg discloses a **record medium storing a browser being executed in a client computer connected through a telecommunication line to a server computer** (see Fig. 1), **the browser for causing the client computer to execute the steps of: interpreting a first embedded command described in a document transferred from the server computer and displaying first image data of an input image when the document is displayed** (paragraph 9); **and interpreting a second embedded command described in the document and printing second image data of the input image with a larger number of pixels than the number of pixels of the first image data when the document is printed** (paragraph 12, the

image is scaled in accordance with the maximum capabilities of the printer which can be a higher resolution than the display image).

Regarding claim 15, Blumberg discloses a **print system comprising a client computer connected through a telecommunication line to a server computer (see Fig. 1) and a printer for receiving print data from the client computer and printing a document (paragraph 91), the print system comprising: a display unit for interpreting a first embedded command described in a document, described in a markup language and transferred from the server computer, and displaying first image data of an input image recorded in the server computer when the document is displayed (paragraph 9); and a print unit for interpreting a second embedded command described in the document and printing second image data of the input image with a larger number of pixels than the number of pixels of the first image data when the document is printed (paragraph 119, prints at a resolution appropriate to printer which can be a higher resolution than display image).**

Regarding claim 16, Blumberg discloses a **server computer comprising: a record unit for recording (see Fig. 7), according to a request made by a second client computer (see Fig. 1, multiple clients), a document described in a markup language (paragraph 42) wherein a first embedded command interpreted when the document is displayed by a first client computer, the first embedded command for causing the first client computer to display first image data of an input image,**

and a second embedded command interpreted when the document is printed by the first client computer (paragraph 9), the second embedded command for printing second image data of the input image with a larger number of pixels than the number of pixels of the first image data of the input image, are described, and the image data of the input image (paragraph 12, the image is scaled in accordance with the maximum capabilities of the printer which can be a higher resolution than the display image); and a transfer unit for transferring, according to a request made by the first client computer, the document and the image data of the input image to the first client computer through a telecommunication line (see Fig. 7).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-9 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Blumberg in view of Crosby et al. (U.S. Patent Application Publication 2005/0052469 A1).

Regarding claim 5, Blumberg discloses **describing, in a document transferred to a client computer through a telecommunication line from a server computer, a first embedded command interpreted when the document is displayed by the**

client computer, the first embedded command causing the client computer to display first image data of the input image (paragraph 9) and a second embedded command interpreted when the document is printed by the client computer, the second embedded command for printing second image data of the input image with a larger number of pixels than the number of pixels of the first image data of the input image (paragraph 12, the image is scaled in accordance with the maximum capabilities of the printer which can be a higher resolution than the display image), and outputting the document with the first and second embedded commands described (paragraph 59).

Blumberg does not disclose expressly **a digital still camera comprising: an image data output unit for outputting image data from an input image; and a markup language output unit.**

Crosby discloses **a digital still camera comprising: an image data output unit for outputting image data from an input image; and a markup language output unit** (paragraph 60, edit list files provide image processing instructions; paragraph 61, a digital camera can be configured to provide edit list data using a markup language).

Blumberg and Crosby are combinable because they are from the same field of endeavor namely image processing. At the time of the invention it would have been obvious to a person of ordinary skill in the art to have Blumberg's system include a digital camera with the capabilities of outputting image processing information in a markup language, as taught by Crosby. The suggestion or motivation for doing so would have been that Blumberg's system could include an image server, which receives

image-processing files directly from a digital camera. Therefore, it would have been obvious to combine the teachings of Crosby with the system of Blumberg to obtain the invention in claim 5.

Regarding claim 6, Blumberg and Crosby disclose the dependent limitations of claim 5 as stated above.

Blumberg further discloses **wherein the image data output unit outputs the first image data and the second image data**(paragraph 59).

Regarding claim 7, Blumberg and Crosby disclose the dependent limitations of claim 5 as stated above.

Blumberg further discloses **wherein the markup language output unit describes in the document a third embedded command interpreted when the document is printed by the client computer, the third embedded command specifying a document layout, and outputs the document with the third embedded command described** (paragraph 23).

Regarding claim 8, Blumberg and Crosby disclose the dependent limitations of claim 7 as stated above.

Blumberg further discloses **wherein the markup language output unit describes in the document a fourth embedded command interpreted when the document is printed by the client computer, the fourth embedded command**

specifying a page break, and outputs the document with the fourth embedded command described (paragraph 42, it is well known in the art how to insert a page break while editing a markup language).

Regarding claim 9, Blumberg and Crosby disclose the dependent limitations of claim 6 as stated above.

Crosby further discloses **further comprising an interface being connected to a communication unit for transferring the document to the server computer through the telecommunication line** (paragraph 80).

Citation of Pertinent Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Kimbell (U.S. Patent Application Publication 2003/0014416 A1) discloses a system for setting image intent using markup language structures.

Wolff et al. (U.S. Patent Application Publication 2005/0120655 A1) discloses a digital camera that uses markup language to send files to a computer system including a monitor and printer.

Safai (U.S. Patent 6,715,003 B1) discloses a digital camera for communicating digital images to a remote server.

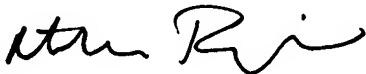
Conclusion

Art Unit: 2627

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Athanasios Tom Papanikolaou whose telephone number is (571)272-7953. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Athanasios Papanikolaou

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PRIMARY EXAMINER
ART UNIT 2622

